

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEAD C. KILLION

Appeal No. 96-0548
Application 08/161,691¹

HEARD: January 14, 1999

Before URYNOWICZ, KRASS, and CARMICHAEL, Administrative Patent Judges.

CARMICHAEL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 39-58, which constitute all the claims remaining in the application.

Claim 39 reads as follows:

39. A hearing aid comprising:

¹ Application for patent filed December 3, 1993. According to appellant, the application is a continuation of Application 08/033,943, filed February 16, 1993, now abandoned, which is a continuation of Application 07/416,703, filed October 3, 1989, now abandoned.

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a hearing aid circuit including means for amplifying audio signals;

a battery connected to supply power to said hearing aid circuit;

alarm means for generating an audio signal in response to the voltage output of said battery falling below a predetermined threshold value, said audio signal being connected for amplification by said means for amplifying, said audio signal having at least one signal component which increases audibility as the voltage of said battery decreases.

The examiner's Answer cites the following prior art:

DeCola et al. (DeCola) 1970	3,550,105	Dec. 22,
Fletcher et al. (Fletcher) 1977	4,049,930	Sep. 20,
Ibsen et al. (Ibsen) 1978	4,086,525	Apr. 25,
Dublirer 1981	4,262,279	Apr. 14,
Iwanaga et al. (Iwanaga) 1981	4,284,944	Aug. 18,
Maas 1983 (German Patent)	3,207,412	Sep. 8,

OPINION

Maas or Fletcher in view of DeCola or Ibsen

All of the pending claims are subject to a rejection based on Maas or Fletcher in view of DeCola or Ibsen. In

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particular: Claims 39-41, 47, 49, 54, and 57 stand rejected under

35 U.S.C. § 103 as unpatentable over Maas in view of DeCola or Ibsen; Claims 39-44, 46-51, 53-55, 57, and 58 stand rejected under 35 U.S.C. § 103 as unpatentable over Fletcher in view of DeCola or Ibsen; Claims 42, 45, 46, 48, 52, 53, 55, 56, and 58 stand rejected under 35 U.S.C. § 103 as unpatentable over Maas in view of DeCola or Ibsen and further in view of Dublirer; Claims 45, 52, and 56 stand rejected under 35 U.S.C. § 103 as unpatentable over Fletcher in view of DeCola or Ibsen and further in view of Dublirer.

These rejections all rely on DeCola or Ibsen to show that an audio signal "can be" varied inversely to a battery voltage. There are two fatal defects in that rationale.

First, "can be" is not the correct standard. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Because the examiner identifies nothing in the prior art suggesting the

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desirability of the modification, no ***prima facie*** case has been stated.

Upon our own review of the references, we agree with Appellant that DeCola and Ibsen have little bearing on the claimed subject matter.

Second, DeCola and Ibsen do not show that an audio signal can be varied inversely to a battery voltage. Neither reference varies an audio signal depending on a battery voltage. Neither reference varies a signal inversely depending on a battery voltage.

We find no suggestion in DeCola or Ibsen for varying the audio signal of Maas or Fletcher inversely to a battery voltage. Therefore, the rejections relying on those references will not be sustained.

Iwanaga

Claims 54 and 57 stand rejected under 35 U.S.C. § 103 as unpatentable over Iwanaga. Claims 55, 56, and 58 stand rejected under 35 U.S.C. § 103 as unpatentable over Iwanaga as applied to Claims 54 and 57, further in view of Dublirer.

For the purposes of these rejections, Claims 54-58 stand or fall together with Claim 54 because appellants have presented no arguments for the separate patentability of the claims under

37 CFR § 1.192.

Claim 54 reads as follows:

54. A battery warning circuit for a hearing aid comprising:

detector means for generating an output signal in response to a fall in battery voltage below a predetermined threshold value, said output signal varying as a function of said battery voltage once said battery voltage falls below said predetermined threshold value;

oscillator means for generating an audio signal in response to said output signal from said detector means, said audio signal having at least one signal component which increases as the voltage of said battery decreases, said signal component selected from the group consisting of amplitude and frequency.

Iwanaga teaches a battery warning circuit for use in any battery operated implement. To indicate a low battery, Iwanaga intermittently sounds a tone. This is illustrated in Fig. 9b during time b'. When the battery becomes even lower, Iwanaga sounds the tone at shorter intervals, *i.e.*, faster. This is illustrated in Fig. 9b during time c'.

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Appellant contends that there are two differences between Iwanaga and the subject matter of Claim 54.

First, Appellant contends that Iwanaga does not increase amplitude or frequency as recited. According to the examiner, increasing the speed of the tones satisfies Claim 54's recitation of increasing the "frequency." Appellant disagrees.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

In the present case, we find that Claim 54's "frequency" may reasonably be read to include how frequently a warning tone is repeated. Appellant points to nothing in the specification with which the examiner's interpretation is inconsistent.

Moreover, although Claim 54 is not so limited, Iwanaga suggests varying the electromagnetic frequency of the warning tone as in Appellant's preferred embodiment. Column 8, lines 39-56.

Second, Appellant contends that Claim 54 requires a battery warning circuit "for a hearing aid," which Iwanaga does not teach.

The examiner concedes that Iwanaga does not show use of the battery warning circuit specifically "for a hearing aid" as stated in Claim 54's preamble. The examiner contends that the phrase "for a hearing aid" is merely a statement of intended use that does not limit the scope of Claim 54.

The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. **DeGeorge v. Bernier**, 768 F.2d 1318, 1322 n.3, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985).

Appellant argues that the phrase "for a hearing aid" should be given limiting effect because it breathes life and meaning into Claim 54.

We agree with the examiner. The phrase "for a hearing aid" has no bearing on the structure recited in the body of Claim 54 and does not breathe life and meaning into the claim. A user of Claim 54's battery warning circuit may just as well intend to use the circuit for a hearing aid, an electric razor, or any other battery-operated implement.

Moreover, although Claim 54 is not so limited, Iwanaga suggests using the battery warning circuit for a hearing aid because a hearing aid is a common battery operated implement. Column 1, lines 5-11.

Therefore, the subject matter of Claim 54 is fully disclosed (or at least suggested) by Iwanaga. The rejections of Claims 54-58 will be sustained.

New Ground of Rejection

Claims 39-58 are hereby rejected under 35 U.S.C. § 103 as unpatentable over Fletcher in view of Iwanaga. Fletcher discloses a hearing aid malfunction detection system and provides to the user an unspecified warning system 30. Thus, to practice Fletcher, one skilled in the art must look to another source for the specifics of a warning system.

Iwanaga provides a warning system for any battery operated electric implement. Column 1, lines 5-11. Iwanaga's system provides an intermittent oscillation to a buzzer. The buzzer sounds intermittently to warn the user of a low battery, and then sounds at lesser intervals when the battery level becomes even more critically low. In other words, the buzzer sounds more frequently. We find that this

is within the broadest reasonable interpretation of the recited increase in "frequency."

It would have been obvious to select Iwanaga's warning system as the warning system 30 in Fletcher to permit the user to recognize the reduction of the capacity of the battery and the extent of the remaining capacity. Iwanaga, column 8, lines 12-17.

CONCLUSION

The rejection of Claims 54 and 57 under 35 U.S.C. § 103 as unpatentable over Iwanaga is sustained. The rejection of Claims 55, 56, and 58 under 35 U.S.C. § 103 as unpatentable over Iwanaga as applied to Claims 54 and 57, further in view of Dublirer, is sustained.

The rejection of Claims 39-41, 47, 49, 54, and 57 under 35 U.S.C. § 103 as unpatentable over Maas in view of DeCola or Ibsen, is not sustained. The rejection of Claims 39-44, 46-51, 53-55, 57, and 58 under 35 U.S.C. § 103 as unpatentable over Fletcher in view of DeCola or Ibsen, is not sustained. The rejection of Claims 42, 45, 46, 48, 52, 53, 55, 56, and 58 under 35 U.S.C. § 103 as unpatentable over Maas in view of

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DeCola or Ibsen and further in view of Dublirer, is not sustained. The rejection of Claims 45, 52, and 56 under 35 U.S.C. § 103 as unpatentable over Fletcher in view of DeCola or Ibsen and further in view of Dublirer, is not sustained.

A new ground of rejection is applied against Claims 39-58.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

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ground of rejection to avoid termination of proceedings (37

CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED 196(b)

STANLEY M. URYNOWICZ)
Administrative Patent Judge)
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) BOARD OF PATENT
)
ERROL A. KRASS) APPEALS AND
Administrative Patent Judge)
) INTERFERENCES
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